

## Remarks

Claims 10-29 are pending in this application. Applicants have amended claims 10-12, and 14 to clarify the present invention. Applicants respectfully request favorable reconsideration of this application.

The Examiner rejected claims 10, 11, 15 and 22 under 35 U.S.C. § 112, second paragraph. The phrases "capable of rotating" and "capable of activating" no longer appear in claim 10. Also, how the photocatalytically active material is placed on the rotating member is clear from the effects of light on the material. Additionally, it is not necessary for the claims to recite how the material is placed on the rotating member. Applicants submit that all pending claims comply with 35 U.S.C. § 112, second paragraph and applicants respectfully request withdrawal of this rejection.

The Examiner rejects claims 10, 11, 15, and 22 under 35 U.S.C. § 102(e) as being anticipated by U.S. patent 7,051,652 to Riepenhoff et al.

Riepenhoff et al. does not disclose the present invention as recited in claim 10 since, among other things, Riepenhoff et al. does not disclose a rotating member having a surface including photocatalytically active material where the surface is in direct contact with a continuous moving material web. Rather, Riepenhoff et al. discloses that the roll surface that is treated is in contact with another roll surface and it never comes in contact with a web. According to the present invention as recited in claim 10, even in cases where the roll is treated

separately, the surface of the rotating member will come in direct contact with the web.

Riepenhoff et al. discloses a web offset printing form having a top layer containing a photocatalytically and thermally modifiable material, which can be brought photocatalytically into a hydrophilic state by irradiation with light and into a lipophilic state by heating. The surface 130 of the material is illustrated in Fig. 1 of Riepenhoff et al. Riepenhoff et al. discloses the surface 130 is formed by the top layer 11 of a printing form 31.

Fig. 3 of Riepenhoff et al. shows the operational location of the material in the apparatus. Riepenhoff et al. describes Fig. 3 in the section beginning at col. 10, line 61. This passage describes two printing plates 31 fastened to a printing form cylinder 32, which is in contact with a rubber blanket cylinder 38, which in turn is in contact with a web 37 to be printed by the rubber blanket cylinder 38. Each of the two printing plates 31 is formed by a printing form according to Riepenhoff et al., as described at col. 10, lines 66 and 67. Consequently, the photocatalytically and thermally modifiable material is on the printing form cylinder 32, which is not in direct contact with the web 37. The light source is also arranged to act on the surface of the printing form cylinder 32 only, as described at, for example, col. 11, lines 31-41.

In view of the above, Riepenhoff et al. does not disclose all elements of the present invention as recited in claim 10, or claims 11, 15 and 22, which depend from claim 10. Since Riepenhoff et al. does not disclose all elements of the present invention as recited in claims 10, 11, 15 and 22, the present invention, as recited in claims 10, 11, 15 and 22, is not properly rejected under 35 U.S.C. § 102(b). For an anticipation rejection under 35 U.S.C. § 102(b) no difference may

exist between the claimed invention and the reference disclosure. *See Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q. 841 (C.A.F.C. 1984).

Along these lines, anticipation requires the disclosure, in a cited reference, of each and every recitation, as set forth in the claims. *See Hodosh v. Block Drug Co.*, 229 U.S.P.Q. 182 (Fed. Cir. 1986); *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986); and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986).

The Examiner rejects claims 12-14, 16-21, and 23-29 under 35 U.S.C. § 103(a) as being unpatentable over Riepenhoff et al.

As described above, Riepenhoff et al. does not suggest a rotating member having a surface including photocatalytically active material where the surface is in direct contact with a continuous moving material web. Modifying Riepenhoff et al. as suggested by the Examiner to control activation speed; control release of the web; utilize UV light; include a roll, paper machine or a continuous web; or control light source movement would not suggest a rotating member having a surface including photocatalytically active material where the surface is in direct contact with a continuous moving material web. Therefore, Riepenhoff et al. does not suggest the present invention as recited in claims 12-14, 16-21, and 23-29.

In view of the above, the reference relied upon in the office action does not disclose or suggest patentable features of the present invention. Therefore, the reference relied upon in the

office action does not anticipate the present invention or make the present invention obvious.

Accordingly, Applicants submit that the present invention is patentable over the cited reference and respectfully request withdrawal of the rejection based on the cited reference.

If an interview would advance the prosecution of this application, Applicants respectfully urge the Examiner to contact the undersigned at the telephone number listed below.

The undersigned authorizes the Commissioner to charge fee insufficiency and credit overpayment associated with this communication to Deposit Account No. 22-0261.

Respectfully submitted,

Date: \_\_\_\_\_

9/13/07



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